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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,783	03/15/2002	Dieter Zimmermann	tesa 1514	4828

7590 07/02/2003

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The use of the trademark Platilon U073 as the backing film, Stabilizer E and Reaktor B, the latter two terms being found in applicant's Examples has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, applicant sets forth as an essential element of his adhesive composition in both the specification and claims the presence of an "activator", which unfortunately does not appear to have been disclosed beyond this vague statement in the specification. Additionally, it appears proper that in the next to last paragraph on page 3 that "absorbent" should be --superabsorbent--, since the only apparent disclosure of this term is found in the bottom paragraph on page 3. Note also that this problem exists in the Markush grouping of claim 6.

Art Unit 1771

3. Claims 1-11 are rejected under 35 U.S.C. § 112, first paragraph.

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim 1, line 3 in two places the word "sidedly" should be --sided-- and it appears proper to delete "of" as the last word of line 3 of claim 1, and also elsewhere such as line 1 of claim 11. In claim 1, next to last line the word "activator" may perhaps just be unduly vague and indefinite, instead of being a 112 first paragraph rejection. In claim 3 proper Markush language should be utilized and in claim 4, lines 2 and 3 the various "optionally" phrases and the capitalized phrase "EBC" is not understood. In claim 6, line 4, it is unclear what the word "which" refers to. In claim 11, line 2, it appears proper to recite the claims 1-10 instead of the "1-8" which presently exists.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit 1771

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admissions in the specification at page 1, bottom two paragraphs taken in view of either Ganster et al. or WO 97/43328. Applicant appears to admit that the claimed adhesive sheet strip and accompanying method of providing an adhesive bond to a surface are essentially known to one of ordinary skill except for the presence of their particular polyurethane adhesive composition which coats the claimed article on at least one surface. However, each of the two relied upon secondary references is believed to disclose (note particularly Ganster et al., the Abstract, column 1 lines 4-10, line 62 - column 2 line 63, column 3 lines 44-67, column 4 lines 35-53, the Examples, claims 1 and 7; WO -328, the Abstract (the Examiner has been unable to obtain an English language equivalent)) adhesive compositions which read upon or render obvious applicant's claimed polyurethane based adhesive which is the apparent point of novelty of the claimed article. Although applicant claims in the bottom paragraph of page 1 of his specification that neither of these two reference polyurethane compositions exhibit *the*

Serial No. 10/099,783

-5-

Art Unit 1771

desirable properties of his claimed adhesive composition and accompanying article, this to date has not been shown on the record by suitable objective evidence, i.e. a Declaration. With respect to applicant's dependent claims, although neither secondary reference discusses the presence of the genus of backings set forth in claim 3, such polymers as polyethylene, polypropylene or polyurethane are believed well known, as are the genus of fillers set forth in claim 6, which are also discussed in Ganster et al. What other parameters that are not either expressly or inherently disclosed, such as the range of thicknesses in claims 2, 8-10 and the utilization of the cross-linking techniques set forth in claim 4 are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the PG Pub U.S. 2003/0054164A1 to the present application, which it is noted appears to inadvertently have a significantly different title than the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

Serial No. 10/099,783

-6-

Art Unit 1771

can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

June 27, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zinker